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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,737	06/01/2001	Thomas A. Soulanille	9623/324	3926
7590	02/24/2004		EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. Box 10395 Chicago, IL 60610			LE, UYEN T	
			ART UNIT	PAPER NUMBER
			2171	12

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/872,737

Applicant(s)

SOULANILLE, THOMAS A.

Examiner

Uyen T. Le

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 05 February 2004.

2a) This action is **FINAL**.                                   2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-13 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. Applicant provided copies of the references cited in the information disclosure statements filed 25 January 2002 and 14 July 2003. Therefore, papers # 2 and 7 have been fully considered.
  
2. Due to newly found prior art, submitted by the applicant, the allowability of claims 1-6 is withdrawn. The finality of the previous Office Action is withdrawn. Applicant's amendment to cancel claims 7-13 has not been entered. Therefore, claims 1-13 are pending.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 7-12, the "random order weighted", "bid amount-weighted random drawing", "bid rank-weighted random drawing" are interpreted by the examiner as an order weighted by the bid amount.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 7-13 are rejected under 35 U.S.C. 102 (e) as being anticipated by Davis et al (US 6,269,361).

Regarding claim 7, Davis discloses all the claimed subject matter (see the abstract, column 4, line 51- column 6, line 34). The claimed "receiving a search request from a searcher" is met when Davis shows the search engine for clients to search (see Figure 1, column 10, lines 7-20). The claimed "in a database...match with the search request" is met by the fact that advertisers in the method of Davis bid for a position in the search listing and accounts of advertisers include search terms (see column 5, lines 18-40, column 9, lines 42-45) . The claimed "selecting... searcher" is met by the fact that the method of Davis limits search listings to a geographical area for example (see column 17, lines 19-45). The claimed "arranging...searcher" is met by the fact that the search results are displayed according to the bid amount and presented to searchers (see column 5, lines 30-40).

Claim 8 merely reads on the fact that the method of Davis, the highest bid listing is displayed before the lower bid listing (see column 18, lines 4-35).

Claim 9 is met when Davis shows that the listings are ordered by bid amount (see column 5, lines 35-40).

Claims 10-12 merely differ from claims 7-9 above by reciting "bid rank" instead of "bid amount". Davis explicitly shows the claimed bid rank (see column 13, lines 16-20, column 18, lines 4-35).

Claim 13 merely differs from claim 7 by not reciting "selecting no more than a predetermined number of identified search listings". Davis discloses all the claimed subject matter as discussed in claim 7 above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jon Swartz "Browser only lists paying web sites" published in the San Francisco Chronicle of February 21, 1998, submitted by the applicant as a printout from the Internet dated 10 September 0-1999, pages 1-3.

Claims 1-6 merely read on the fact that Open Text of Canada began charging for preferred placement on its search engine since 1996 (see page 2). Although it is not explicitly shown that Open Text displays the search listings in a random order, it would have been obvious to one of ordinary skill in the art to do so in order to arbitrarily present paid listings without having to rank them.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 703-305-4134. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21 February 2004



UYEN LE  
PRIMARY EXAMINER